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EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,832

Applicant(s)

KHOO ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/5/2001, 12/4/2002, 10/31/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-10, 18-30 is/are pending in the application.
- 4a) Of the above claim(s) 22, 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-10, 18-21, 23-27, 29-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22 and 28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11B.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Detailed Action

1. This Office Action is in response to the original application, the Preliminary Amendments filed 4/5/2001 and 12/4/2002 (papers #4 and 12), the Petition to Make Special filed 10/31/2002. All amendments are entered. Claims 3, 11-17 are deleted. Claims 1-2, 4-10, 18-30 are now pending. Claims 1, 7,8,9,10, 18, 19, 23 are independent. During a telephone conversation with Mr. James Jakobsen, on January 16, 2003, an election was made without traverse to prosecute the invention of Species I, 1-2, 4-10, 18-20, 23,26. However upon reconsideration, the restriction on claims 21, 27, 24-25, 29-30 is withdrawn. The restriction on claims 22 and 28 is maintained. 1-2, 4-10, 18-21, 23-27, 29-30 will now be examined.

Examiner's Note

2. **The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all references passages as potentially teaching all or part of the claimed inventions.**

Restriction

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Claims 1-2, 4-10, 18-20, 23, 26, 21, 27, 24-25, 29-30 are drawn to methods, system and/or apparatus for classifiable in class/subclass 705/14.

II. Claims 22 and 28 are related to modeling/simulation classified at least in class/subclass 717/104.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Presently claims 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of

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an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. During a telephone conversation with Mr. James Jakobsen, on January 16, 2003, an election was made without traverse to prosecute the invention of Species I, 1-2, 4-10, 18-20, 23. Affirmation of this election as above-modified must be made by applicant in replying to this Office Action.

8. Claims 22 and 28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

9. The inventions I and II are distinct, each from the other because:

(1) the genus (invention I) as claimed does not require the particulars of the species as claimed for patentability, and (2) that the species (Invention II) has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the inventions of Group I as claimed does not require the particulars of the species II as claimed because modeling/simulation are the particulars of the species which is not required in the combination invention of Group I for patentability.

Further, the Group II species features, such as cited above, have separate utility by themselves or in other combinations because all these features of modeling/simulation are not required in the claims of Group I.

10. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. **Claims 5, 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is not clear what the “apportioning a weighted significance” step in claim 5 means. “Weighted significance is defined , at specifications p. 20, l. 17-20 as “ the amount of significance given to the coefficient values ...”. However, the phrase further states “... that is in turn based on the target individual’s demand”. Since claim 5 mentions a saturation level which is based on demand, a weighted significance which is also based on demand, and several other factors such as “age, income, gender, hobby” in addition to the “saturation level” in the “apportioning” step, it is unclear whether each of these factors is needed in the apportioning step and whether the coefficients are applied to each of them. Fig 5 is not appropriate to support claim 5 as drafted. Appropriate correction is required. By virtue of is dependency, Claim 6 is rejected as well.

For prior art purposes, it is interpreted that each of the factors such as a demand for a target consumer, an age, an income, a gender, a hobby are weighed, for each target customer.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. **Claims 1-2, 4-10, 18-20, 23, 26 and their other related dependent claims are rejected under this section as claimed inventions directed to non-statutory subject matter.**

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Claims 1-2, 4-7, 9, 10, 18-20, 23, 26 and their other related dependent claims are inventions that do not fall within the technological arts because Applicant has carefully avoided to tie the disclosed and claimed invention to any technological art or environment, see in Ex Parte Bowman , 61 USPQ2d 1669, (BdPatApp and Int 2001)

All the method steps of independent claims 1, 7,9 10, 18, 19, 23 such as receiving constraints, searching an inventory, comparing profiles for matches, determining a price based on matches , transmitting a price, receiving an order...all can be performed manually without interaction of a physical structure or machine;

Also, "over a data network" in the preamble of some of the independent claims is insufficient as the preamble is not accorded patentable weight unless it is "necessary to give life, meaning and vitality" to the claim . MPEP 2111.02.

For the same reasons, independent claims 1, 7,9 10, 18, 19, 23 are also rejected under 35 U.S.C. 101 because the claimed methods do not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). ("for on-line interactive communications" in one limitation is deemed not sufficient as a recital of a useful, concrete and tangible result as well.)

Because the independently claimed inventions do not fall within the technological arts and are directed to abstract and intangible ideas which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recited statutorily permitted subject matter.

In order to overcome this rejection it is suggested that Applicants amend the claims, at the very least, to include "over a computer network" in the body of the claims.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-2, 4-10, 18-21, 23-27, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, US 5,724,521 A.

Dedrick discloses

Claim 1(Once Amended) A method for ordering an advertising spot for an advertisement over a data network to be transmitted to one or more target users during transmission of a motion picture (“*The software tools may also allow the publisher/advertiser to combine different types of information. For example, the publisher can combine video, audio, graphics, animation and text all within the same unit of electronic information provided to the end user*”), comprising:

receiving from an advertiser one or more predetermined constraints defining the one or more target users (see at least “*In one embodiment, the consumer scale provides a range of particular numbers of consumer variables which must be satisfied by particular numbers of end users served by a metering server 14 in order for the advertiser 18 to pay a particular price*”;

determining a price for the advertising spot using the one or more predetermined constraints (see at least “*At the metering servers, a determination is made as to where the characteristics of the end users served by each of the metering servers fall on the consumer scale. The higher the characteristics of the end users served by a particular metering server fall, the higher the fee charged to the advertiser*;

The consumer scale for a particular advertisement is dependent on the consumer variables the advertiser 18 selects to associate with the advertisement. In one embodiment, the advertiser 18 is provided with a GUI which presents a set of consumer variables from which the advertiser 18 can select. The advertiser 18 is also able to select certain consumer characteristics which must be met in order for the advertiser 18 to agree to pay a specified fee for delivery of the advertisement to the consumers”

Thus, the present invention allows individual advertisers to pay for access to individual consumers based on how desirable it is to the advertiser to access those consumers. The fee for access to consumers is based on the value the advertiser places on different consumer characteristics which apply to each individual electronic advertisement. Thus, the advertiser pays more for access to consumers it finds highly desirable, and pays less for those consumers it is

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less interested in.); and

transmitting to the advertiser the price for the advertiser's acceptance, rejection, or counteroffer (see at least, "... (e) charging a fee to the advertiser based on the comparing..." .

The advertiser 18 is also provided with software tools to generate a "consumer scale " for each individual advertisement. The consumer scale represents the value of the advertisement to the advertiser in terms of the consumer characteristics of the end users which will consume the advertisement. In one embodiment, the consumer scale provides a range of particular numbers of consumer variables which must be satisfied by particular numbers of end users served by a metering server 14 in order for the advertiser 18 to pay a particular price . The advertiser 18 then transfers this consumer scale along with the advertisement to the yellow page servers 22, where it is subsequently made available to the end users of the metering servers 14.

Thus, the consumer scale provides a mechanism by which a metering server 14 can determine how valuable the end users coupled to that server 14 are to the advertiser 18. The advertiser 18 indicates how much it is willing to pay for access to those end users, based on the consumer characteristics of those end users.

In one embodiment, an indication is returned from each metering server 14 to the advertiser 18 indicating where the metering server 14 falls on the consumer scale. The advertiser 18 is then able to modify the consumer scale or any other information relating to the advertisement, including the advertisement itself, and resend the advertisement to the metering servers 14 via the yellow page servers 22 to attempt a better match of end users to the consumer scale. (counteroffer)

--2. (Once Amended) The method of claim 1, wherein the one or more predetermined constraints are demographic information selected from the group consisting of gender, income, hobby, and age. (see claim 5)

--4. (Once Amended) The method of claim 1, wherein the determining step searching an individual inventory containing a plurality of individuals, each of the plurality of individuals having a profile, the searching performed to determine the one or more target users by comparing the one or more predetermined constraints to the profiles of the plurality of individuals to locate matches between the one or more predetermined constraints and the profiles of the plurality of individuals; and

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determining from the matches a price for transmitting the advertisement to the one or more target users based on a predetermined formula

(see at least

"...Each metering server 14 also contains a consumer scale matching process 39. When the metering server 14 receives a unit of electronic information which includes an electronic advertisement identifier (such as a title) and consumer scale from a yellow page server 22, the consumer scale is transferred to the consumer scale matching process 39. The consumer scale matching process 39 then compares the consumer scale to the aggregate user profile data stored in the user profile database 30. The fee that the metering server 14 charges the advertiser 18 is dependent on how well the consumer scale matches aggregate user profile data. For example, the aggregate user profile data for the end users served by a particular metering server 14 falls at a particular point along the consumer scale. This particular metering server 14 then charges the advertiser 18 the fee indicated by this particular point for access to the end users of the metering server 14...")

As to claims 5 and 26 (claim 26 is broader than claim 5) , Dedrick discloses:

--5. (Once Amended) The method of claim 4, wherein the predetermined formula comprises:

apportioning a weighted significance to a saturation level, an age, an income, a gender (Dedrick mentions demographic profiles which include age income gender) , and a hobby of each of the one or more target users, the saturation level corresponding to a demand for each target user to receive the advertisement

(see at least" ...The consumer scale for a particular advertisement is dependent on the consumer variables the advertiser 18 selects to associate with the advertisement. In one embodiment, the advertiser 18 is provided with a GUI which presents a set of consumer variables from which the advertiser 18 can select. The advertiser 18 is also able to select certain consumer characteristics which must be met in order for the advertiser 18 to agree to pay a specified fee for delivery of the advertisement to the consumers. –

In one embodiment, the software tools also allow the advertiser 18 to place different "weights" on different consumer variables. For example, the advertiser 18 may select five different consumer variables to associate with a particular advertisement. The advertiser 18 may assign a 35% weight to each of the first two variables and a 10% weight to each of the three remaining variables.

Additionally, the tools may also allow the publisher to request that the unit of information be directed only to end users that have a certain profile. For example, the

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publisher/advertiser may request that a unit of information be directed only to male end users or end users that have historically viewed news items.

As to hobby, Dedrich mentions psychometric factors such as preferences, interest, likes and dislikes as part of consumer profiles and of advertisers monitoring same thus it would have been obvious to include hobby as one of the ad targeting constraints as well in view of Dedrick teachings of user profiles and of using such to match with ads.)

As to demand , see claim 6 where demand is time.

-As to claim 6.(Once Amended) The method of claim 5, wherein the demand for each target user further comprises an amount of time available for each target user to receive the advertisement,

Dedrich does not disclose that one of the predetermined formula factors is demand based on time . However, Dedrich discloses, in another embodiment, pay to the customer per viewing time, monitor of viewing time, thus one skilled in the art would have found it obvious from this teaching that time available to view an ad is a desirable commodity to advertisers thus it would have been obvious to incorporate available viewing time as a factor to include in Dedrick's predetermined formula (the consumer scale)

(
(see at least " For example, the metering process 36 may monitor the amount of time an end user spends viewing an electronic advertisement, or which particular advertisement ... "

Claim 7 is a combination of claims 1 and 4 and is rejected on the same basis.

Claims 8 parallels claim 7 in system format and is rejected on the same basis.

Claims 9 and 10 parallel claim 1 and 7 in computer readable medium format, respectively, and are rejected on the same respective basis.

Claims 18, 19, 20 substantially parallel claims 1, 4, 5 in system format and are rejected on the same bases.

-- 23. (New) A method for an advertiser to order an advertising spot for an advertisement over a data network to be transmitted to one or more target users during transmission of a motion picture, comprising:

transmitting to a broadcaster one or more predetermined constraints defining the one or more target users that the advertiser desires to receive the advertisement;

receiving an offer from the broadcaster to purchase an advertising spot at a price, the price determined by the broadcaster comparing the one or more predetermined constraints to profiles of a plurality of individuals to locate matches there between, the matches identifying the one or more target users, and calculating the price based on the matches and a predetermined formula; and

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transmitting an order for the advertising spot to the broadcaster. –

Claim 23 substantially parallels claims 1 and 4 and is rejected on the same basis.

As to claims 21 and 27, Dedrich impliedly discloses wherein the predetermined formula accounts for a supply and demand for the plurality of individuals in the individual inventory. (see claims 5-6)

As to claims 24 and 29 Dedrick discloses the step of transmitting the advertisement to the one or more target users during transmission of the motion picture (see claim 1)

As to claims 25 and 30 Dedrick discloses the step of providing demographic information characterizing the one or more target users that receive the advertisement. (see claim 5)

Conclusion

17. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eldering US 6,216,129 discloses An advertisement selection system is presented in which vectors describing an actual or hypothetical market for a product or desired viewing audience can be determined. An ad characterization vector is transmitted along with a consumer ID. The consumer ID is used to retrieve a consumer characterization vector which is correlated with the ad characterization vector to determine the suitability of the advertisement to the consumer. The consumer characterization vector describes statistical information regarding the demographics and product purchase preferences of a consumer, and is developed from previous purchases or viewing habits. A price for displaying the advertisement can be determined based on the results of the correlation of the ad characterization vector with the consumer characterization vector. Eldering can be used to reject at least claim 1.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

May 17, 2003

KHL



STEPHEN GRAVINI
PRIMARY EXAMINER